

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	William David Schaefer	Confirmation No. 6931
Application No.:	10/829,493	Examiner: Edwards, Jr., Timothy
Filed:	April 22, 2004	Art Unit: 2612
Patent No.:	7,532,131	Issued: May 12, 2009
For:	MULTI-LAYER SOLID STATE KEYBOARD	

**REQUEST FOR RECONSIDERATION**

Mail Stop PETITIONS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

Applicants respectfully submit that the Office of Petitions' Decision on Petition issued on April 7, 2009 ("the Decision") in connection with Applicants' Petition Under 37 C.F.R. § 1.78(a)(3) to Accept an Unintentionally Delayed Claim of Priority Under 35 U.S.C. § 120 filed on November 13, 2008 ("the Petition") is improper and respectfully request reconsideration thereof and grant of the Petition.

On November 13, 2008, Applicants paid the issue fee in this case. On the same date, and in the same filing as the issue fee payment, Applicants also filed the Petition, the petition fee set forth in 37 C.F.R. § 1.17(t), and an Amendment After Allowance Under 37 C.F.R. § 1.312 ("the Rule 312 Amendment") to incorporate into the specification a claim for benefit of priority to an earlier filed application.

On April 7, 2009, the Office of Petitions issued the Decision, summarily dismissing the Petition on the ground that “a petition under 37 CFR 1.78(a)(3), along with the submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed non-provisional application after issuance of the application into a patent” and further on the ground that “[t]he petition fails to [include the reference to the prior-filed application required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i)]. In this regard, the amendment submitted with the petition was filed concurrently with the payment of the issue fee is not acceptable.” Title 37 C.F.R. § 1.312 (“Rule 312”), however, provides that

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before *or with* the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

Title 37 C.F.R. § 1.312 (Thomson Reuters 2009) (emphasis added).

Based on this provision of Rule 312 and the fact that Applicants filed their Petition, fee, and Rule 312 Amendment (including the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2)(i)) with the payment of the issue fee and, therefore, *before* the issue of the present application as a patent (indeed, the present application still has not issued as a patent), Applicants believed that the basis set forth in the Decision for denial of their Petition was improper.

Accordingly, on April 27, 2009, Applicants’ undersigned attorney contacted April M. Wise of the Office of Petitions to discuss the basis for dismissal of the Petition. Ms. Wise advised Applicants’ attorney that the Office dismissed the Petition because Applicants’ Rule 312 Amendment was deemed to have been filed after payment of the issue fee. Applicants’ attorney pointed out that the Rule 312 Amendment was in fact filed *with* payment of the issue fee and therefore was timely filed under 37 C.F.R. § 1.312 (“Rule 312”). Ms. Wise responded that the

Office no longer considered amendments under Rule 312 filed with payment of the issue fee on the ground that the Office deems amendments filed *with* payment of the issue fee to be filed *after* payment of the issue fee. Ms. Wise, however, provided no authority for this position.

Applicants submit that the Office's foregoing position that an amendment under Rule 312 filed with the issue fee is untimely has no legitimate basis. To the contrary, Rule 312 itself explicitly provides that an amendment under Rule 312 filed *with* the issue fee is timely filed.

Applicants submit that their Petition and Rule 312 Amendment were both timely and substantively proper. Applicants filed their Rule 312 Amendment with their payment of the issue fee. As such, Applicants' Rule 312 Amendment was timely filed. Also, Applicants' Rule 312 Amendment included the reference to an earlier filed application as required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i). As such, their Rule 312 Amendment was substantively proper. Moreover, Applicants' Rule 312 Amendment accompanied their Petition as required by 37 C.F.R. § 1.78(a)(3). As such, their Petition was substantively proper.

In view of the above, Applicants respectfully request that the Office reconsider its Decision, enter Applicants' Rule 312 Amendment into the application, and grant the Petition.

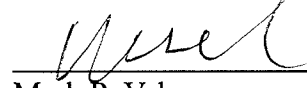
Applicants note that Ms. Wise also indicated that the Office improperly charged a petition fee of \$1610, rather than the proper fee under 37 C.F.R. § 1.17(t) of \$1400. Applicants' undersigned attorney respectfully requests a refund of any overcharge.

Applicants respectfully request that the Office direct all further communications regarding this matter to Applicants' undersigned attorney.

Attorney Docket No. 37041-11449  
Application No. 10/829,493

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read 'M. Vrla', is written over a horizontal line.

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Dated: April 30, 2009